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EXAMINER
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BROWN, ALVIN L

ART UNIT	PAPER NUMBER
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4127

MAIL DATE	DELIVERY MODE
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10/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/799,977

Applicant(s)

DEMEYER ET AL.

Examiner

Alvin L. Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This communication is a first Office Action Non-Final rejection on the merits.

Claims 1- 17, as originally filed, are currently pending and have been considered.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 2, 12, 13, 15, 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 and 12 recites the limitation "the value" on line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the purchasing of a product" on line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "the purchasing of a product" on line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "the safety information" on line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "the product" on line 4. There is insufficient antecedent basis for this limitation in the claim. In line 5, the term "the" is missing before "product".

Claim 17 recites the limitations "the transfer" at line 1, "the purchase" at line 3, "the value" at line 5, and "the safety information" at line 12. There is insufficient

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antecedent basis for these limitations in the claim. In line 16, the term "the" is missing before "product".

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 12 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Marcus (US 2002/0077902 A1).**

**As per claim 12**, Marcus teaches a method of ensuring the transfer of data in instruction material from a first party to a second party comprising the steps of:

providing the second party with a set of instructional materials containing an embedded piece of information (see paragraph [0022] which teaches a first party such as a product or service provider that provides instructions to a second party such as an information consumer. The provided information contains embedded pieces of information such as signifiers referenced here as anything perceivable by an information consumer);

querying the customer as to the value of the embedded piece of information (see paragraphs [0085] through [0089] which teach the second party such as an information

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consumer is given instruction on how to indicate knowledge of an embedded pieces of information such as a signifier by responding specifically with a requested value);

providing the customer a rebate after determining that the embedded information provided by the customer has a proper value (see paragraph [0042] which teaches that a second party/consumer receives a coupon after reviewing a series of advertisement and providing the system with a code number).

**As per claim 15**, Marcus teaches querying a customer as to whether it has additional questions as to the safety information (see paragraph [0105] which teaches that a second party/customer verifies that he or she has reviewed and comprehended the user's manual but still needs assistance).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1 –11, 13 –14, 16 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcus (US 2002/0077902 A1) in view of Herzen et al., (US 2002/0099652 A1)**

**As per claim 1**, Marcus teaches a method of ensuring the transfer of data in instruction material from a first party (via a service provider) to a second party (via an information consumer) comprising the steps of:

providing the second party with a set of instructional materials containing an embedded code (see paragraph [0022] which teaches a first party such as a product or service provider that provides instructions to a second party such as an information consumer. The provided information contains embedded codes such as signifiers referenced here as anything perceivable by an information consumer);

querying the second party as to the value of the embedded code (see paragraphs [0085] through [0089] which teach the second party such as an information consumer is given instruction on how to indicate knowledge of an embedded code such as a signifier by responding specifically with a requested value).

However, Marcus fails to disclose providing the second party a rebate after a predetermined amount of time.

Herzen et al., teaches a method that permits electronic transmission of payment or a rebate with steps of providing the second party a rebate after a predetermined amount of time (see paragraph [0122] which discloses a first party such as Internet company provides a second party such as a new member with an incentive that is redeemable after 90 days in the future).

From the teachings of Herzen et al., it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the transfer of data in instruction material from one party to another of Marcus with an incentive with a predetermined time period as taught by Herzen et al. The motivation to combine Marcus with the system described by Herzen et al., is to ensure that customers fully understand the information contained in the instruction manual of the product they purchased.

**As per claim 2**, Marcus teaches the structural elements of the claimed invention. However, Marcus fails to disclose that a second party receives the instructional material upon the purchasing of a product.

Herzen et al., teaches a method that permits electronic transmission of payment or a rebate with steps of a second party receiving the instructional material upon the purchase of a product (see paragraph [0119] which teaches that a second party/customer purchases an E-machine and receives product registration information which contains a rebate code, that can be redeemed once the registration process is completed).

From the teachings of Herzen et al., it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the transfer of data in instruction material from one party to another of Marcus with instructional material such as the registration material embedded with a rebate code as taught by Herzen et al. The motivation to combine Marcus with the system described by Herzen et al., is to ensure that customers fully understand the information contained in the instruction manual of the product they purchased.

**As per claim 3**, Marcus teaches the structural elements of the claimed invention. However, Marcus fails to disclose if the product has been returned prior to providing a second party a rebate, and if it has been return preventing providing a second party the rebate.

Herzen et al., teaches a method that permits electronic transmission of payment or a rebate with steps that if a product has been returned prior to providing a second

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party a rebate, and if it has been return preventing providing a second party a rebate (see paragraphs [0119] and [0122] which teach that a second party/customer acceptance of a rebate signifies that he/she waives their right to return the product. Or in the case of an internet subscriber getting a rebate denied if they disconnect from the service before a predetermined time).

From the teachings of Herzen et al., it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the transfer of data in instruction material from one party to another of Marcus with rebate restrictions and conditions as taught by Herzen et al. The motivation to combine Marcus with the system described by Herzen et al., is to ensure that customers fully understand the information contained in the instruction manual of the product they purchased and to reduce fraud in the rebate system.

**As per claim 4**, Marcus teaches a method of instructional material contained in one of a video, digital format, or a written manual (see paragraphs [0084] and [0100] which teach instructional material on different formats such as print media, audio visual program, digital format such as DVD or CD-ROM or an internet web site).

**As per claim 5**, Marcus teaches querying the second party as to whether it has additional questions as to the instructional material (see paragraph [0105] which teaches that a second party/customer verifies that he or she has reviewed and comprehended the user's manual but still needs assistance).

**As per claim 6**, Marcus teaches providing data to the second party on how to gain further information from one of an information phone center or a website (see



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paragraph [0105] which teaches that a second party/customer is provided with a toll-free number in the instructional material to call in case he or she require additional information).

**As per claim 7**, Marcus teaches retrieving serial number and safety codes from the second party and entering them into a database (see paragraph [0167] which teaches a database designed to capture the second party/customer information such as safety codes which in this case are signifiers).

**As per claim 8**, Marcus teaches the second party inputs the embedded codes from the instructional materials into a phone center using a telephone's key pad touch tone (see paragraph [0090] which teaches that a customer contacts a call center by dialing a toll-free number).

**As per claim 9**, Marcus teaches the second party enters the value of the embedded code using a telephone key pad (see paragraph [0090] which teaches that a customer contacts a call center by dialing a toll-free number).

**As per claim 10**, Marcus teaches the structural elements of the claimed invention. However, Marcus fails to disclose comparing the entered value of the embedded code with a known value.

Herzen et al., teaches a method that permits electronic transmission of payment or a rebate with steps of comparing the entered value of the embedded code with a known value (see paragraph [0088] which teaches that a second party/customer submits the value of an embedded code such as a printed coupon or financial

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instrument to a financial institution where the financial institution checks the submitted value against an internal list).

From the teachings of Herzen et al., it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the transfer of data in instruction material from one party to another of Marcus with rebate restrictions and conditions as taught by Herzen et al. The motivation to combine Marcus with the system described by Herzen et al., is to ensure that customers fully understand the information contained in the instruction manual of the product they purchased and to reduce fraud in the rebate system.

**As per claim 11**, Marcus teaches the structural elements of the claimed invention. However, Marcus fails to disclose sending a notification to the second party if the entered value does not equal the known value.

Herzen et al., teaches a method that permits electronic transmission of payment or a rebate with steps of sending a notification to the second party if the entered value does not equal the known value (see paragraph [0090] which teaches that a second party/customer receives a notification information for receiving the financial instrument).

From the teachings of Herzen et al., it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the transfer of data in instruction material from one party to another of Marcus with rebate restrictions and conditions as taught by Herzen et al. The motivation to combine Marcus with the system described by Herzen et al., is to ensure that customers fully understand the information

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contained in the instruction manual of the product they purchased and to reduce fraud in the rebate system.

**As per claim 13**, Marcus teaches the structural elements of the claimed invention. However, Marcus fails to disclose that a customer receives a user manual upon the purchasing of a product.

Herzen et al., teaches a method that permits electronic transmission of payment or a rebate with steps of a customer receiving a user manual upon the purchase of a product (see paragraph [0119] which teaches that a customer purchases an E-machine and receives product registration information which contains a rebate code, that can be redeemed once the registration process is completed).

From the teachings of Herzen et al., it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the transfer of data in instruction material from one party to another of Marcus with instructional material such as the registration material embedded with a rebate code as taught by Herzen et al. The motivation to combine Marcus with the system described by Herzen et al., is to ensure that customers fully understand the information contained in the instruction manual of the product they purchased.

**As per claim 14**, Marcus teaches a method of a user manual is contained in one of a video, digital format, or a written manual (see paragraphs [0084] and [0100] which teach instructional material on different formats such as print media, audio visual program, digital format such as DVD or CD-ROM or an internet web site).

**As per claim 16**, Marcus teaches a method providing data to the customer on how to gain further information from one of an information phone center or visit a website (see paragraph [0105] which teaches that a customer is provided with a toll-free number in the instructional material to call in case he or she require additional information). However, Marcus fails to disclose if the product has been returned prior to providing a customer a rebate, and if the product has been returned preventing providing the customer the rebate.

Herzen et al., teaches a method that permits electronic transmission of payment or a rebate with steps that if the product has been returned prior to providing a customer a rebate, and if the product has been returned preventing providing the customer the rebate (see paragraphs [0119] and [0122] which teach that a customer's acceptance of a rebate signifies that he/she waives their right to return the product. Or in the case of an internet subscriber getting a rebate denied if they disconnect from the service before a predetermined time).

From the teachings of Herzen et al., it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the transfer of data in instruction material from one party to another of Marcus with rebate restrictions and conditions as taught by Herzen et al. The motivation to combine Marcus with the system described by Herzen et al., is to ensure that customers fully understand the information contained in the instruction manual of the product they purchased and to reduce fraud in the rebate system.

**As per claim 17**, Marcus teaches a method of ensuring the transfer of safety information in a user manual to a customer comprising the steps of:

the user manual containing an embedded piece of information (see paragraph [0022] which teaches a customer is provided information such as a user manual that has embedded pieces of information such as signifiers referenced here as anything perceivable by an information consumer);

querying the customer as to the value of the embedded piece of information (see paragraphs [0085] through [0089] which teach the second party such as an information consumer is given instruction on how to indicate knowledge of an embedded code such as a signifier by responding specifically with a requested value); and

providing the customer a rebate after determining that the embedded information provided by the customer has a proper value, wherein the user manual is contained in one of a video, digital information, or a written manual (see paragraph [0042] which teaches that a customer receives a coupon after reviewing a series of advertisement and providing the system with a code number and also paragraphs [0084] and [0100] which teach instructional material on different formats such as print media, audio visual program, digital format such as DVD or CD-ROM or an internet web site);

querying the customer as to whether the customer has additional questions as to the safety information (see paragraph [0105] which teaches that a customer verifies that he or she has reviewed and comprehended the user's manual but still needs assistance).

providing data on how to gain further information from one of an information phone center or visit a website (see paragraph [0105] which teaches a customer is provided with a toll-free number in the instructional material to call in case he or she require additional information).

However, Marcus fails to disclose: providing the customer with a user manual at the purchase of a product; and

if the product has been returned prior to providing a customer a rebate, and if the product has been returned, preventing providing a customer the rebate.

Herzen et al., teaches a method that permits electronic transmission of payment or a rebate with steps of providing the customer with a user manual at the purchase of a product (see paragraph [0119] which teaches that a customer purchases an E-machine and receives product registration information which contains a rebate code, that can be redeemed once the registration process is completed); and

if a product has been returned prior to providing a second party a rebate, and if the product has been returned, preventing providing a second party a rebate (see paragraphs [0119] and [0122] which teach that a second party/customer acceptance of a rebate signifies that he/she waives their right to return the product. Or in the case of an internet subscriber getting a rebate denied if they disconnect from the service before a predetermined time).

From the teachings of Herzen et al., it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the transfer of data in instruction material from one party to another of Marcus with rebate restrictions and

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conditions as taught by Herzen et al. The motivation to combine Marcus with the system described by Herzen et al., is to ensure that customers fully understand the information contained in the instruction manual of the product they purchased and to reduce fraud in the rebate system.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Junger (U.S. 6,834,268 B2) discloses a method and apparatus for efficient handling of product return transactions.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin L. Brown whose telephone number is 571 270 5109. The examiner can normally be reached on Monday - Thursday 7:30 AM to 5:00 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on 571 270 3033. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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ALB

 10/29/07  
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SUPERVISORY PATENT EXAMINER